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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,856	01/26/2004	Curtis A. Cole	JBP0554CIP	9796
27777	7590	06/30/2006	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/764,856	<b>Applicant(s)</b> CURTIS COLE	
	<b>Examiner</b> Gina C. Yu	<b>Art Unit</b> 1617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/27/04, 8/11/05</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The disclosure of the prior-filed application, Application No. 09/742920 and 09/961911, fail to provide adequate support in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The present invention is directed to a method of simultaneously cleansing the skin and reducing skin sensitivity and/or skin reactivity; a method for ameliorating redness or inflammation of mammalian skin; a method for ameliorating the irritating effects of a skin irritating a cleansing surfactant; and a method of reducing the irritation of a topical skin treatment. Application no. 09/742920 and 09/961911 are directed to the method of treating aging skin and do not disclose the presently claimed methods. Accordingly, claims 1-20 are not entitled to the benefits of the prior applications.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by US**

**61624190 (Perricone).**

'190 discloses a skin cleansing foam comprising 0.5 % by weight of dimethylaminoethanol, anionic surfactant (sodium lauryl sulfate) and amphoteric surfactant (cocamidopropyl betaine) in water. See Example 3; instant claims 1-4, 6, 7 and 11. The reference teaches that the composition comprising dimethylaminoethanol or other acetylcholine precursors are applied to skin "to achieve skin tightening and smoothing effects", which reads on the claimed method of anti-aging skin treatment of the present claims, claims 15 and 19. See col. 5, lines 35 – 55. The reference also teaches that "typical embodiments contain from about 0.1-5 % by weight dimethylaminoethanol. See col. 5, lines 35 – 55. See instant claim 5. The reference also teaches that a "typical composition" according to the invention comprises 0.1-5 % dimethylaminoethanol and L-tyrosine. See col. 6, lines 45 – 56; instant claim 5.

The reference does not specifically teach the method of reducing skin sensitivity and/or skin reactivity with the prior art cleanser. However, under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. In re King, 801 F.2d 1324, 231

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USPQ 136 (Fed. Cir. 1986). Thus, cleansing the skin with the '419 foam cleanser in its normal use would necessarily perform the claimed method.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 8-12 are rejected under 35 U.S.C. 103(a) over Perricone (US 6162419) as applied to Claims 1-7 as above, and further in view of Fowler (US 5635469).**

Perricone fail to teach the surfactants of the instant claims.

Fowler teaches a skin cleansing and conditioning composition. Among the preferred nonionic lathering surfactants for the invention are cocoamidopropyl betains, sodium lauryl sarcosinate, lauryl polyglucoside, and decyl polyglucoside. See col. 7, lines 1-38; Examples. See instant claims 7 and 8. Sorbitan oleate, sorbitan stearate, sucrose cocoate, and sucrose stearate are also said to be "essentially useful group of emollients" for the invention. See col. 12, lines 1 – 31. See instant claims 9 -11. Producing lather by using sponges or washcloths on the skin is mentioned in col. 2, lines 33 – 48. See instant claim 17. The reference teaches incorporating anti-wrinkle and anti-skin atrophy actives, particularly including, glycolic acids and lactic acids. See col. 14, line 35 – col. 15, line 11.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding the lathering surfactants and emollients of Fowler because 1) Perricone (US 6162419) teaches of a cleansing composition comprising anti-aging actives; and 2) Fowler teaches preferred lathering surfactants and essential emollients for a skin cleansing/conditioning composition. The skilled artisan would have had a reasonable expectation of successfully producing a cleansing composition with good lathering, skin conditioning, and anti-aging properties because 1) all references teach using alpha hydroxyl acids; and 2) Müller ('467) teaches using the acid salts of alkanolamine to overcome the disadvantages of insolubility and skin irritation of using the acids.

**Claims 1-7, 9-20 are rejected under 35 U.S.C. 103(a) over US 6071541 (Murad) in view of US 6743433 B2 (Perricone).**

'433 teaches a method of treating inflammatory condition of acne by applying a skin cleanser comprising 2 % of dimethylaminoethanol, 0.2 % tyrosine, and 0.2 % lipoic acid. See Example 1. The reference also teaches that pretreating the skin with a composition comprising dimethylaminoethanol, tyrosine, and lipoic acid significantly reduced skin irritation caused by retinoid. See Example 2.

'433 fails to teach a cleanser formulation comprising surfactants.

'541 teaches a method of treating skin conditions including rosacea, acne, perioral dermatitis, and other inflammatory skin conditions with a cleanser comprising active ingredients (salicylic acid and benzoyl peroxide), surfactants, and water. See

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Example 1; instant claims 7, 9, 10. It is also noted that the active ingredients are potentially skin-irritating agents.

It would have been obvious to one of ordinary skill in the art at the time the present invention was made to modify the teaching of '433 by formulating the skin cleansing composition by adding the surfactants of '541 as motivated by the references because 1) '433 teaches a cleanser composition which has efficacy of reducing skin inflammation caused by acne and irritation caused by skin treatments; and 2) '541 teaches a specific cleansing gel formulation comprising deterative/foaming surfactants.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-7 and 9-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over**

**claims 1-4, 5 and 6 of copending Application No. 09/677,737 in view of US 6,743,433 B2 and US 6,071,541.**

The '737 application claims a method of ameliorating redness or inflammation of mammalian skin, by topically applying to red or inflamed skin a composition comprising an alkanolamine of the recited formula in a cosmetically acceptable carrier. See claim 1. Claim 5 requires that the composition comprises 1-5 % of dimethylaminoethanol and 1-5 % of tyrosine. The claims do not require a cleansing surfactant.

The '433 patent, as discussed above, teaches a method of treating inflammatory condition of acne by applying a skin cleanser comprising 2 % of dimethylaminoethanol, 0.2 % tyrosine, and 0.2 % lipoic acid. See Example 1.

The '541 patent, as discussed above, teaches a method of treating skin conditions including rosacea, acne, perioral dermatitis, and other inflammatory skin conditions with a cleanser comprising active ingredients (salicylic acid and benzoyl peroxide), surfactants, and water. See Example 1.

It would have been obvious to one of ordinary skill in the art at the time the present invention was made to modify the invention of '677 application by adding to the composition a cleansing surfactant as motivated by '433 and '541 because 1) '433 teaches that the same alkanolamine composition claimed in '677 is used as anti-inflammatory agent in a cleanser form; and 2) '541 teaches adding specific cleansing surfactants to formulate a cleansing composition for inflammatory skin conditions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



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***Conclusion***

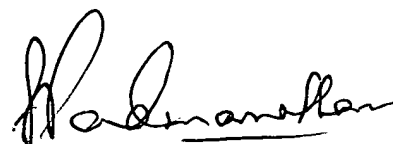
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 7:00AM until 4:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gina Yu  
Patent Examiner



**SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER**